

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Gilbert Wolrich et al. Art Unit : 2155
Serial No. : 09/475,614 Examiner : David Y. Eng
Filed : December 30, 1999 Conf. No. : 6580
Title : METHOD AND APPARATUS FOR CONTROL OF RECEIVE DATA

Mail Stop Appeal Brief - Patents

Commissioner for Patents
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REPLY BRIEF

Pursuant to 37 C.F.R. § 41.41, Applicant responds to the Examiner's Answer as follows.

The examiner states: "Appellants' remarks from page 7 to line 3 of page 10 are considered moot because they are not arguments. Those pages contain citations of the authorities and what they understand of Allison's disclosure." Appellant disagrees. Those remarks are not moot, and as the Board will agree, they form part of what the rules require Appellant to provide and on which Appellant has every right to rely.

Claims 1 and 18

The examiner states: "The request is not actually a request. The request as recited is actually a command instructing the system to transfer data from one of a plurality of ports to a buffer memory. It is a command because there are no steps recited for accepting or rejecting the request and no steps for deciding what to do if the request is accepted or rejected. The claims recite that data is transferred in response to the request. The request therefore is a command." Appellant contends that this reasoning is irrelevant and immaterial to the claimed subject matter. Whether the examiner characterizes the feature as a command or a request, is immaterial and a matter of semantics, because the functionality of the claim as a whole is not present in Allison.

The examiner then states: Reference is now made to Allison. In Figure 9 of Allison, data is transferred from one of a plurality of ports to a buffer memory. The command in Allison is generated when it is determined that one of a plurality of ports requires service because the port has data waiting to be transferred. Appellant had argued that what the Examiner later stated what was considered to be the request was

"... The request in Allison is taught in Figure 9 and demonstrated in Figure 1. In response to a request (the signal S which initiates the transfer shown

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in Figure 9), data is transferred from one of the ports (see ports 1-n in Figure 1) to RxFIFO for the control logic to process."¹

The Examiner identified "S" in FIG. 9 as the "issuing of a request specifying a data transfer" and presumably the request to modify in view of Belkin to include identification of a thread. However, "S" in FIG. 9 is neither a request nor a command. It is a flow chart symbol that begins with an "S" ("Start") symbol and ends with an "E" ("End") symbol enclosed in rounded terminators, conforming to a flow chart convention understood by one of ordinary skill in the art.

Accordingly no combination of Allison and Belkin teaches: "issuing a receive request based on the determination, the receive request directing the transfer of data from the one of the plurality of peripheral ports to a buffer memory."

The examiner also argues that: "Appellants contend that Allison does not teach: specifying a program thread from among of a plurality of processing program threads to process the data The Examiner disagrees. Reference is made to the 103 Rejection above. Allison teaches a plurality of groups of instructions for processing the data depending on the state of the machine. If the groups of instructions are organized in a multithread environment as taught by Belkin, a thread would be selected from among a plurality of threads for processing the data so that the system would run more efficiently." As for the reasons stated in the Appeal Brief, the combination of Allison and Belkin are incompatible. Belkin is merely cited to show that a thread is a known feature. However, the examiner needs to furnish more reasoning than that a thread is known.

The Supreme Court in *KSR Intl. Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007), even while stating that: "the Court of Appeals drew the wrong conclusion from the risk of courts and patent examiners falling prey to hindsight bias," warns that: "a factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning."

The Court of Appeals, finally, drew the wrong conclusion from the risk of courts and patent examiners falling prey to hindsight bias. A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning. See *Graham*, 383 U. S., at 36 (warning against a "temptation to read into the prior art the teachings of the invention in issue" and instructing courts to "guard against slipping into the use of hindsight") (quoting *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply*

¹ (page 3, office action mailed 1/19/05)

Co., 332 F. 2d 406, 412 (CA6 1964))). Rigid preventative rules that deny factfinders recourse to common sense, however, are neither necessary under our case law nor consistent with it.

The examiner is conducting the consummate exercise in *ex post* reasoning, by using Appellant's claim as a roadmap to pick out the elements that the examiner needs to find in the prior art and then place those elements together without regards to whether the suggested combination makes any logical sense.

Claim 17

The examiner states: "The second step of claim 17 is the same single step recited in claims 1 and 18. Appellants do not provide any argument as to why the rest of the steps other the second step are patentable over the applied references. It appears that Appellants rely on the second step of claim 17 for patentability. Claim 17 therefore stands or falls with claims 1 and 18." Appellant acknowledges that the second limitation of claim 17 is the same limitation as recited in claims 1 and 18. Therefore, the arguments for patentability of claims 1 and 18 over the combination of Allison and Belkin also apply to claim 17.

For these reasons, and the reasons stated in the Appeal Brief, Applicant submits that the final rejection should be reversed.

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Respectfully submitted,

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